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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,538	04/12/2004	Roger W. Engelbart	7784-000696	3341
27572	7590	06/22/2006	EXAMINER	
HARNES, DICKEY & PIERCE, P.L.C.			ROSENBERGER, RICHARD A	
P.O. BOX 828			ART UNIT	
BLOOMFIELD HILLS, MI 48303			PAPER NUMBER	
			2877	

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/822,538	ENGELBART ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Richard A. Rosenberger	2877	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>see attached</u> . | 6) <input type="checkbox"/> Other: ____.  |

1. Claims 24-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

See the OG Notice of 22 November 2005, *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, which sets for the current Office policy regarding such claims. In particular, in Annex IV, the OG Notice states in part of computer related materials:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component...

And states

Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se.

Here claims 24-29 fall into the category above of "functional descriptive material"; they consist of no more than a computer program which imparts functionality when employed as a computer component, and are claimed as descriptive material per se. Thus, according to the guidelines set forth in the OG Notice, they are directed to nonstatutory subject matter.

2. Claims 15-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 sets forth elements, including a controller and “a program executable by the controller ...”. The program as claimed is “descriptive functional material” as discussed above, with the program is claimed as a separate element, not as a functional part of the controller. This leaves the exact meets and bounds of the claim unclear, as it is unclear whether the claimed program is actually part of the functioning of the controller, or merely a potential or intended use of the controller.

Dependent claims 16-18, 22, and 23 also claim such “descriptive functional material” absent any actual claimed connection to the apparatus.

Claims 19-21 at least inherit this rejection from their respective parent claims.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beck et al (US 6,639,660).

The reference teaches a method and system for indicating defects by automatically causing a light source to direct light to the defect location; see, for example, column 2, lines 13-35 for a general description, and column 2, lines 55- 57 for a

disclosure of using such a system to mark defects. Note the computer control in column 2, line 65.

While the reference specifically deals with vehicle bodies as the objects on which the defects are to be marked, it would have been obvious to use this known system with any type of manufactured object in any appropriate time in the manufacturing process in which it is desired to mark in order to gain the sorts of benefits discussed by the reference (column 1, line 66 through column 2, line 6, for example).

The computer, to direct the light beam at the desired position on the object, must have available the relevant positional data of position to be marked; obtaining this information from existing files would have been obvious because this would not require the creation of additional specialized files for this purpose. Note the disclosure relating to the use of CAD data (column 3, line 12), which at least suggests using such otherwise available data.

To mark a flaw with the system of the reference, the flaw must be first found. The reference discusses the use of inspection systems to determine flaws (for example, column 1, lines 28-36), and the use of such inspection system to locate the flaws is at least suggested by the reference.

The light source of the reference may be laser (column 2, lines 52-54). The reference also contemplates the projection of symbols or color codes onto the object (column 3, lines 8-12); using such codes to present useful information, such as the type of defect being marked, is at least obvious given the teaching of such coding.

Figure 1 of the reference show projecting a plurality of marks simultaneously; see column 2, lines 60-62.

Having the system mark the flaw until it is repaired would have been obvious because this would help eliminate the possibility that a flaw would go unrepaired should the operator be, for example, distracted. Having the system mark only defects that are judged to require repair or other attention would have been obvious because marking flaws that are minor enough not to require special attention would slow down the process and require unnecessary effort by the operator.

5. Note the initialed and signed copies of the information disclosure forms filed 04/12/2004, 06/07/2004, 11/13/2004, 01/10/2005, 07/12/2005, and 12/08/2005. Document number 4 on the information disclosure statement filed 1/10/2005 has been lined through because a copy is not in the file and the information on the form is insufficient to otherwise identify the document. It is noted that on the second and third sheets of the information disclosure statement filed 06/07/2004, the serial number and filing date are not for this application, although the first sheet and the cover letter do appear to be for this application.

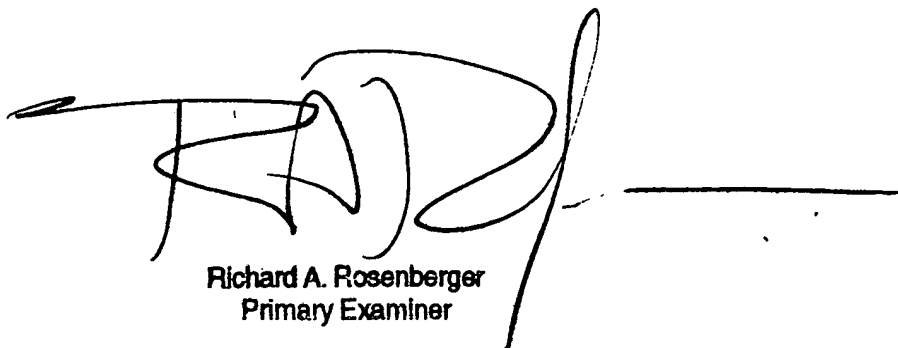
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard A Rosenberger whose telephone number is (571) 272-2428. The examiner can normally be reached on Monday through Friday during the hours of 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr. can be reached on (571) 272-2800 ext. 77. The fax phone number for the organization where this application or proceeding is assigned is

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703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

R. A. Rosenberger  
15 June 2006



Richard A. Rosenberger  
Primary Examiner